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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,554	06/16/2006	Nikolco Gidalov	NL031511	7841

24737 7590 10/14/2008

PHILIPS INTELLECTUAL PROPERTY & STANDARDS
P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

EXAMINER	
SU, SARAH	

ART UNIT	PAPER NUMBER
2431	

MAIL DATE	DELIVERY MODE
10/14/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/596,554	GIDALOV, NIKOLCO	
	Examiner	Art Unit	
	Sarah Su	2431	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 June 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☒ Claim(s) *2-6,8,11,12,15-18 and 20-24* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 June 2006* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-30 are presented for examination.

Priority

2. The claim for priority from PCT/IB04/52674 filed on 6 December 2004 is duly noted.

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The

disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

5. The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

6. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading.

(a) TITLE OF THE INVENTION.
(b) CROSS-REFERENCE TO RELATED APPLICATIONS.
(f) BACKGROUND OF THE INVENTION.
    (1) Field of the Invention.
    (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
(g) BRIEF SUMMARY OF THE INVENTION.
(h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
(i) DETAILED DESCRIPTION OF THE INVENTION.
(j) CLAIM OR CLAIMS (commencing on a separate sheet).
(k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

Claim Objections

7. It is noted that claims 1-2, 4-5, 7-10, 12-15, 17, 19-20, 22, 25-30 contain the symbol "-" which is non-functional. The examiner requests that these be removed.

8. Claims 2-6, 8, 11-12, 15-18, 20-24 are objected to because of the following informalities:

a. As to claims 2-6, line 1: "Method" is unclear if it relates to "A method" (claim 1, line 1);

b. As to claim 4, line 2: "a computer program element" is unclear if it relates to "a computer program element" (claim 1, line 1);

c. In claim 6, line 3: "the step of storing" lacks antecedent basis;

d. In claim 8, lines 4-5: "said computer program element" lacks antecedent basis;

e. In claims 11 and 12, line 1: "Computer program product" is unclear if it relates to "Computer program product" (claim 10, line 1);

f. In claims 15-18, line 1: "Method" is unclear if it relates to "Method" (claim 14, line 1);

g. In claim 16, line 1: "the third key" lacks antecedent basis;

h. In claim 17, line 3: "the third key" lacks antecedent basis;

i. In claim 18, line 2: "the public and the private key" lacks antecedent basis;

j. In claims 20-24, line 1: "Method" is unclear if it relates to "Method" (claim 19, line 1);

k. In claim 23, line 2: "the public and the private key" lacks antecedent basis;

l. In claim 24, line 1: "the third key" lacks antecedent basis.

Appropriate correction is required.

Drawings

9. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 114 (Figure 1).

10. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because:

a. reference characters "404", "426", and "432" have been used to designate the 3rd key/session key Ks;

b. reference characters "416" and "422" have both been used to designate private key;

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 6, 8, 16, 17, and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites the limitation "the step of storing" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "said computer program element" in lines 4-5. There is insufficient antecedent basis for this limitation in the claim.

Claims 16, 17, and 24 recite the limitation "the third key" in lines 1 and 3, respectively. There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 101

13. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 9, 13, 28, and 30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims are drawn to a computer program per se. Computer programs claimed as computer listings per se are abstract instructions Computer programs are neither

computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. As such, these claims are not directed to one of the statutory categories of invention (See MPEP 2106.01), but are directed to nonstatutory functional descriptive material.

Please note that computer programs embodied on a computer readable medium or other structure, which would permit the functionality of the program to be realized, would be directed to a product and be within a statutory category of invention, so long as the computer readable medium is not disclosed as non-statutory subject matter per se (electromagnetic signals or carrier waves).

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 1-3 and 6-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Garcia (US Patent 7,380,120 B1).

As to claims 1 and 7-9, Garcia discloses a system and method for access control with a secured data format, the system and method having:

extracting at least one static resource (306) (i.e. header) **of said computer program element (step 102)** (col. 11, lines 38-42; col. 26, lines 22-23),

encrypting the at least one static resource (306) with a key (314, step 106) (col. 11, lines 45-48).

As to claim 2, Garcia discloses:

storing the at least one encrypted static resource (310) in said computer program element (step 110) (col. 11, lines 48-50).

As to claim 3, Garcia discloses:

in which the key (314) is a public key of a public/private key pair (col. 23, lines 25-28).

As to claim 6, Garcia discloses:

wherein the step of extracting (step 102) comprises extracting the at least one static resource (306) from a certain position in the program element and the step of storing (step 110) comprises storing the encrypted static resource (310) in said position (col. 11, lines 41-50).

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. Claims 10-14, 17-19, 23, and 25-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Sigbjørnsen et al. (US Patent 6,266,416 B1 and Sigbjørnsen hereinafter). As to claims 10 and 13, Sigbjørnsen discloses a system and method for protection of software against use without permit, the system and method having:

at least one static resource encrypted with a key (310) (col. 6, lines 65-66; col. 8, line 50)**.**

As to claim 11, Sigbjørnsen discloses:

where said key (314) is a public key of a public/private key pair (col. 7, lines 36-38)**.**

As to claim 12, Sigbjørnsen discloses:

wherein said computer program code means further comprises: said public key (314) (col. 7, lines 13-14)**.**

As to claims 14, 25, 27 and 28, Sigbjørnsen discloses:

obtaining at least one static resource (406) encrypted with a first key (314), in a first entity (52) (col. 8, line 50)**,**

providing said at least one encrypted static resource (406) to a second entity (54, step 208) (col. 8, lines 52-53)**,**

obtaining by said first entity (52) said at least one static resource (430) from the second entity (54, step 210), where the encryption according

to the first key (314) has been decrypted using a second key (422) (col. 8, lines 54-55, 58-59).

As to claim 17, Sigbjørnsen discloses:

obtaining the first key (408) (col. 7, lines 38-39),

encrypting the third key (408) and said at least one encrypted static resource (406), by using said first key(408, step 206) (col. 8, lines 5-7, 49),

and in which the step of providing (step 208) said at least one encrypted static resource (410) to the second entity (54) comprises providing said third key (404) (i.e. authentication key) **and said at least one encrypted static resource (406)** (i.e. encrypted data)**, both encrypted (410) by using the first key (408)** (col. 7, lines 45-46; col. 8, lines 52-53).

As to claim 18, Sigbjørnsen discloses:

in which the first key (314, 408) and the second key (316) is the public and the private key, respectively, of a public/private key pair (col. 7, lines 35-37).

As to claims 19, 26, 29 and 30, Sigbjørnsen discloses:

obtaining at least one encrypted static resource (414) from a first entity (52, step 218), which at least one static resource (306) has been encrypted by using a first key (314) (col. 8, line 50),

obtaining a second key (416, step 216) (col. 7, lines 40-42),

decrypting said at least one encrypted static resource (418), by using said second key (416, step 222) (col. 8, lines 54-55, 58-59),

providing said at least one static resource (424) to the first entity (52, step 228) (col. 8, lines 58-60)**.**

As to claim 23,Sigbjørnsen discloses:

in which the first key (314) and the second key (416, 422) is the public and the private key, respectively, of a public/private key pair (col. 7, lines 35-37)**.**

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

19. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garcia as applied to claim 3 above, and in view of Sigbjørnsen.

As to claim 4, Garcia does not disclose:

storing the public key (314) in a computer program element (step 112).

Nonetheless, this feature is well known in the art and would have been an obvious modification of the teachings disclosed by Garcia, as evidenced by Sigbjørnsen.

Sigbjørnsen discloses:

storing the public key (314) in a computer program element (step 112) (col. 7, lines 13-14).

Given the teaching of Sigbjørnsen, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Garcia with the teachings of Sigbjørnsen by storing the public key in the element. Sigbjørnsen recites motivation by disclosing that making the keys available to protected software allows the execution of the program to continue as usual and accommodate when an encrypted parameter is reached (col. 7, lines 14-16). It is obvious that the teachings of Sigbjørnsen would have improved the teachings of Garcia by storing the public key in an element so that execution does not have to be interrupted when an encrypted parameter is reached.

As to claim 5, Garcia discloses:

obtaining the corresponding private key (316) (col. 26, lines 26-27).

Garcia does not disclose:

storing said private key (316) in an entity (318) separate from an entity in which the computer program element is provided (step 114).

Nonetheless, this feature is well known in the art and would have been an obvious modification of the teachings disclosed by Garcia, as evidenced by Sigbjørnsen. Sigbjørnsen discloses:

storing said private key (316) (i.e. second key) **in an entity (318) separate from an entity in which the computer program element is provided (step 114)** (col. 3, lines 30-32).

Given the teaching of Sigbjørnsen, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Garcia with the teachings of Sigbjørnsen by storing a private key on a separate device. Sigbjørnsen recites motivation by disclosing that placing the decryption keys on a device such as a smart card makes them hidden to the user (col. 7, lines 64-65). It is obvious that the teachings of Sigbjørnsen would have improved the teachings of Garcia by storing a private key on a separate entity so that it would be hidden from the user.

20. Claims 15-16, 20-22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sigbjørnsen as applied to claims 14 and 19 above, and further in view of Metlitski et al. (US 2001/0037450 A1 and Metlitski hereinafter).

As to claims 15 and 20, Sigbjørnsen does not disclose:

obtaining a third key (step 202),

decrypting the at least one encrypted static resource (430), by using the third key (step 212),

wherein which the step of providing (step 208) comprises providing the third key (404) and said at least one encrypted static resource (406, 410) to the second entity (54), and the step of obtaining (step 210) by said first

entity (52) said at least one static resource (430) from the second entity (54), comprises obtaining the at least one static resource encrypted (430) with the third key (426), so that the computer program element can be executed.

Nonetheless, these features are well known in the art and would have been an obvious modification of the teachings disclosed by Sigbjørnsen, as evidenced by Metlitski. Metlitski discloses a system and method for process protection, the system and method having:

obtaining a third key (step 202) (0153, lines 1-4)**,**

decrypting the at least one encrypted static resource (430), by using the third key (step 212) (0156, lines 17-19)**,**

wherein which the step of providing (step 208) comprises providing the third key (404) and said at least one encrypted static resource (406, 410) to the second entity (54), (0150, lines 12-15; 0154, lines 3-5, 12-17) **and the step of obtaining (step 210) by said first entity (52) said at least one static resource (430) from the second entity (54), comprises obtaining the at least one static resource encrypted (430) with the third key (426), so that the computer program element can be executed** (0151, lines 3-5)**.**

Given the teaching of Metlitski, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Sigbjørnsen with the teachings of Metlitski by using a key for decryption so that a program can be executed. Metlitski recites motivation by disclosing that using

an additional parameter in the enciphering algorithm increases cryptographic security (0152, lines 1-3). It is obvious that the teachings of Metlitski would have improved the teachings of Sigbjørnsen by using a third key to decrypt a resource in order to increase the cryptographic security.

As to claims 16 and 24, Sigbjørnsen does not disclose:

in which the third key (404, 432) is a random session key.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the teachings disclosed by Sigbjørnsen, as evidenced by Metlitski. Metlitski discloses:

in which the third key (404, 432) is a random session key (0154, lines 15-17).

Given the teaching of Metlitski, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Sigbjørnsen with the teachings of Metlitski by using a session key. Metlitski recites motivation by disclosing that using a new key for each working session protects data generated and used at a certain execution (0153, lines 5-7). It is obvious that the teachings of Metlitski would have improved the teachings of Sigbjørnsen by using a session key in order to protect data during a specific program execution.

As to claim 21, Sigbjørnsen discloses:

wherein the at least one encrypted static resource (406) and the third key (404), are obtained encrypted (414), which encryption has been made using the first key (314) (col. 7, lines 45-46; col. 8, lines 52-53).

As to claim 22, Sigbjørnsen discloses:

decrypting by using the second key (416) , the encrypted (414) at least one encrypted static resource (406) and the third key (404, step 220) (col. 7, lines 45-49; col. 8, lines 54-55, 58-59).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah Su whose telephone number is (571) 270-3835. The examiner can normally be reached on Monday through Friday 7:30AM-5:00PM EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sarah Su/
Examiner, Art Unit 2431

/Christopher A. Revak/
Primary Examiner, Art Unit 2431